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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,500	06/19/2006	Toyohiko Takushige	SHOBA5.001APC	3693

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EXAMINER

KOSINSKI, IRINA Y

ART UNIT	PAPER NUMBER
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1612

NOTIFICATION DATE	DELIVERY MODE
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08/07/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary	Application No. 10/583,500	Applicant(s) TAKUSHIGE ET AL.	
	Examiner IRINA KOSINSKI	Art Unit 4131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/18/2006, 06/19/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election with traverse of Group I (claims 7-8) in the reply filed on 06/10/2009 is acknowledged. The traversal is on the ground that inventions of Group I and IV both require the special technical feature of PEG having three polymerization degrees and propylene glycol, and therefore they relate to a single general inventive concept as stated in PCT Rule 13.2. This is not found persuasive because, even though the inventions of Group I and IV require the technical feature of PEG having three polymerization degrees and propylene glycol, this technical feature is not a special technical feature as it does not make a contribution over the prior art in view of Vermeer (USPatent# 5624906), which will be discussed in detail below.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-6, 9-12 and 13-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in the reply filed on 06/10/2009. Claims 7-8 are being considered by the Examiner.

Information Disclosure Statement

1. The information disclosure statements (IDSs) submitted on 12/18/2006 and 06/19/2009 were submitted by the applicant. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

1. The disclosure is objected to because of the following informalities: spelling error on page 23, line 20 (word "lime").

Appropriate correction is required.

2. The use of the trademarks, such as ASUZOLE® has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. This applies to pages 10, 11, 19, 20, 24 and 25.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 7 is rejected under 35 U.S.C. 102(b) as anticipated by Vermeer (US Patent# 5624906).

5. Vermeer teaches an oral composition comprising antibacterial agent (column 35, line 65), polyethylene glycol 400, polyethylene glycol 600, polyethylene glycol 4000 and propylene glycol and mixtures thereof, (column 18, lines 1-25), encompassing instant claim 7-

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vermeer (US Patent# 5624906).

8. Vermeer teaches an oral composition comprising antibacterial agent (column 35, line 65), polyethylene glycol 400, polyethylene glycol 600, polyethylene glycol 4000 and propylene glycol and mixtures thereof, present in the composition from about 0% to about 80% by weight (column 18, lines 1-25), encompassing instant claims 7-8.

9. Reference discloses range of 0% to 80% by weight, which presents a situation analogous to the obviousness of a species when the prior art broadly discloses a genus (*In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (Fed.Cir. 1994); *In re Jones* F.2d 347, 21USPQ2d 1941 (Fed. Cir. 1992); MPEP §2144.08, MPEP §2144.05).

10. It would have been prima facie obvious for the one skilled in the art to use teachings of Vermeer concerning a broad range for the PEG with various polymerization degrees in order to formulate a composition with desired properties.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IRINA KOSINSKI whose telephone number is (571)270-1334. The examiner can normally be reached on Monday through Friday 7:30 to 5:00.

Art Unit: 4131

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on (571)272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/IRINA KOSINSKI/
Examiner, Art Unit 4131

/Patrick J. Nolan/
Supervisory Patent Examiner, Art Unit 4131